

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. EGNOR

Appeal No. 2001-0043
Application 08/828,560

ORDER REMANDING TO EXAMINER

An examination of the file reveals that a facsimile received June 2, 1999 containing a drawing of the subject matter on appeal and a draft of a new claim 12 is attached to the back cover of the application file (No paper number). There is no indication in the record that this paper has been considered. Further, the amendment has not been physically entered. If the amendment is entered, the language of the claims appearing in the Appendix to the Appeal Brief filed March 27, 2000 (Paper No. 16) will differ from its last amended version. In addition, the

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Amended Appeal Brief does not comply with section 1206(9) of the Manual of Patent Examining Procedure (MPEP) (7th Ed., Rev. 1, Feb. 2000), which states:

The copy of the claims required in the brief Appendix by 37 CFR 1.192(c)(9) should be a clean copy and should not include any brackets or underlining as required by 37 CFR 1.121(a)(2).

The Amended Appeal Brief filed March 27, 2000 (Paper No. 16) states that "[o]n July 19, 1999, appellant appealed from the final rejections of claims 1-12" (page 1 under the caption "Status of Claims"). The Examiner's Answer mailed July 13, 2000 (Paper No. 17) states that "[t]he statement of the status of the claims contained in the brief is correct" (page 2 under the caption "Status of Claims"). However, it should be noted that the Examiner fails to discuss the status of claim 5.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. for clarification of the entry status of the facsimile received June 2, 1999 (No paper number) and for written notification to appellant of the action taken;

2. for notification to appellant to submit a new Appendix to the Appeal Brief which contains a correct, clean copy

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of the claims, or for issuance of a supplemental Examiner's Answer which contains a correct, clean copy of the claims (This would only apply if the amendment filed June 2, 1999 (No paper number) is entered.);

3. for notification to appellant to submit a new Appendix to the Appeal Brief filed on March 27, 2000 (Paper No. 16) which contains no underlining or brackets;

4. for clarification regarding the status of claim 5;
and

5. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
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